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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,817	10/24/2005	Philippe Stalder	5019-1003	6462
466	7590	10/17/2007		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER GOODWIN, JEANNE M	
			ART UNIT 2833	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,817

Applicant(s)

STALDER ET AL.

Examiner

Jeanne-Marguerite Goodwin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-, 8-10, 12, 16, 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-, 8-10, 12, 16, 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 6-9, 14 and 15 is withdrawn in view of the newly discovered reference(s) to US 6618328 to Ellner et al. [hereinafter Ellner], US 6751164 to Sekiguchi, US 46657922 Sato, US 4348751 to Kosaka et al. [hereinafter Kosaka], US 5696741 to Nussbaum, US 6491424 to Tardy. Rejections based on the newly cited reference(s) follow.

Claim Objections

2. Claims 8 and 16 objected to because of the following informalities:
 - a. In claim 8, line 3: "said cavity" lacks antecedent basis;
 - b. In claim 12, line 4: "the cover" lacks antecedent basis; and
 - c. In claim 16, line 4: "said identification element" lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

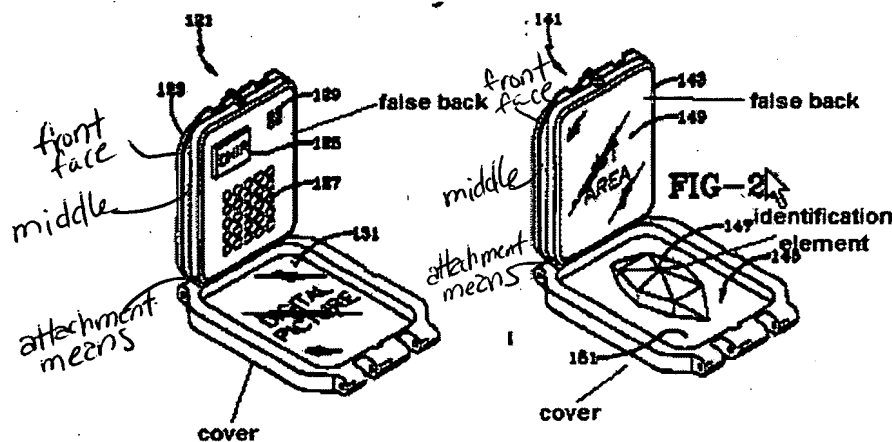
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 17 rejected under 35 U.S.C. 102(e) as being anticipated by Ellner.

Regarding claim 1: Ellner discloses a back of a watch case (Figs. 20 and 21) comprising a cover (see figures below) that defines the external surface of the back, characterized by a false back (see figures below) installed against the internal surface of said cover (see figures below), wherein an identification element (125 or 147) is installed between said cover and said false back (see figures below).



With respect to the method claim 17: the method steps will be met during the normal assembly of the apparatus stated above.

Regarding claim 2: Ellner discloses the back of a watch case according to the claim 1, wherein said false back (see figures above) comprises a decoration/speaker (127).

Regarding claim 3: Ellner discloses the back of a watch case according to claim 2, wherein said decoration (127) appears to be marked in the thickness of said false back (see figures above).

Regarding claim 4: Ellner discloses the back of a watch case according to claim 1, wherein said false back (see figures above) appears to have an even thickness and wherein said

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cover (see figures above) comprises means of attachment (75) (Figs. 12 and 13) to the middle (see figures above) of the watch case.

Regarding claim 5: Ellner discloses the back of a watch case according to claim 1, wherein said false back (see figures above) is attached securely against said internal surface of said cover (Fig. 12 and 13).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner in view of Sekiguchi.

Regarding claim 16: Ellner further teaches that the identification element/functional element (147) could be used to indicate the whereabouts of the watch assembly or of the wearer of the watch assembly. Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 16, i.e., wherein the identification element comprising an antenna. Sekiguchi teaches using a sensor means (79) comprising an antenna for a GPS system for recognizing location information. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the electronic circuit, as taught by Ellner, with the sensor means/electronic circuit, as taught by Sekiguchi,

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since both are alternative types of electronic devices which will provide the same function, if one is replaced with other, generating location information, respectively.

7. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner and Sekiguchi as applied to claim 16 above, and further in view of Sato.

Regarding claim 8: Ellner and Sekiguchi discloses a device as stated above with regards to claim 16. Ellner and Sekiguchi disclose all the subject matter claimed by applicant with the exception of the limitation stated in claim 8, i.e., wherein an electronic circuit is fixed in a cavity by way of a double-sided adhesive. Sato discloses an electronic circuit/antenna (4) being fixed in a cavity (12) by way of a double-sided adhesive (13) (col. 3, lines 5-11). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the double-sided adhesive, as taught by Sato, to the electronic circuit, in order to for the electronic circuit to be securely set in the case.

8. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner, Sekiguchi and Sato as applied to claims 8 and 16 above, and further in view of Kosaka.

Regarding claim 9: Ellner, Sekiguchi and Sato discloses a device as stated above with regards to claims 8 and 16. Ellner, Sekiguchi and Sato disclose all the subject matter claimed by applicant with the exception of the limitation stated in claim 9, i.e., wherein an electronic circuit is coated with a resin. Kosaka discloses using a resin on the an integrated circuit (IC) (col., 3, lines 15-33). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the resin of Kosaka, to the electronic device, as taught by

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Sekiguchi, in order provide moisture proof, sock resistance, chemical stability, etc., as already suggested by Kosaka (col., 3, lines 15-17).

9. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner.

Regarding claim 10: Ellner discloses a device as stated above with regards to claim 1. Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 10, i.e., the cover and/or the false back made of metal. The particular material used to make the cover and/or false back, absent any criticality, is only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide a metal material, as claimed by Applicant, for the cover and/or false back of Ellner since it has been held to be a matter of obvious design choice and within the general skill of worker in the art to select a known material on the basis of its suitability for the intended use of the invention.

10. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner, US 5696741 to Nussbaum and US 6491424 to Tardy.

Regarding claim 12: Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 12, i.e., a process of production of the back of a watch case, comprising the following step: installation of a false back against the internal surface of the cover of the back, comprising, moreover, a prior step of stamping of said false back from a plate of even thickness, and performing a prior step of engraving of a decoration on one surface of said plate. Nussbaum discloses the process of fastening a container/false back (20) with the

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back cover (2c) by the process of stamping. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the process of production of the back cover/false back assembly by stamping, as taught by Nussbaum, to the process of production of Ellner, in order to reduce manufacturing costs, as already suggested by Nussbaum (col., 4, lines 40-46). Tardy discloses the process of engraving a decoration on a surface. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the process of production of engraving of a decoration, as taught by Tardy, to the process of production of Ellner, in order create a personalized message.

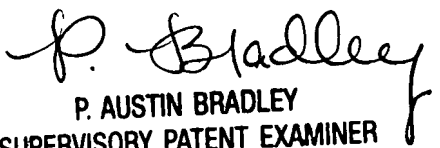
Response to Arguments

11. Applicant's arguments with respect to claims 1-5, 8-10, 12, 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Jeanne-Marguerite Goodwin whose telephone number is (571) 272-2104. The examiner can normally be reached on Monday-Friday (9am-6pm), alternate Fridays off. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2861.

JMG


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